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In the

Supreme Court of the United States

OCTOBER TERM, 1940

No.....

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as JAX BREWING COMPANY,
Petitioner.

vs.

CONWAY P. COE, United States Commissioner of Patents, and JACKSON BREWING COMPANY, a corporation.
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

Jax Ice & Cold Storage Company, a corporation of the State of Florida, trading as Jax Brewing Company, prays for a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia entered on December 9, 1940.

OPINIONS BELOW

This matter was determined first by the District Court of the United States for the District of Columbia, without opinion, and, upon appeal, by the United States Court of Appeals for the District of Columbia, by *per curiam* decision of December 9, 1940, not yet reported.

JURISDICTION

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether Commissioner of Patents is a proper and adverse party in an equitable action, under Section 4915, *Revised Statutes*, Title 35, *U. S. Code*, Section 63, brought by a defeated applicant for cancellation to compel cancellation of a trade-mark registration.

STATUTES INVOLVED

The statutes involved are set out in the Appendix, *infra*, pp. 17, 18 and 19.

STATEMENT

Petitioner, a corporation of Florida, filed applications in the Patent Office for cancellation of two registrations of a single trade-mark in the name of respondent, Jackson Brewing Company, a Louisiana corporation, claiming ownership of the trade-mark in four Southeastern States. Its applications were summarily denied on motions of the registrant and it proceeded thereafter, under Section 4915, *Revised Statutes*, by bill in equity in the District Court of the United States for the District of Columbia, naming as defendants, the registrant, Jackson Brewing Company, and Conway P. Coe, Commissioner of Patents. A decree, adjudicating the rights of petitioner, requiring the delivery up by Jackson Brewing Company of its certificates of registration, and rectification of the Trade-Mark Register accordingly by the Commissioner, was prayed (R. 1 through 6).

Jurisdiction of the District Court for the District of Columbia was predicated upon Section 4915, *Revised Statutes* (Title 35, *U. S. Code*, Section 63); Section 9, *Trade-Mark Act of* 1905; (Title 15, *U. S. Code*, Section 89), and Section 72 a, Title 35, *U. S. Code*, the parties defendant residing in different judicial districts (R. 2 and 6).

The complaint was dismissed by the District Court on pleas by both defendants (R. 16 and 17), it being the contention of the Commissioner of Patents that he was not a proper party under the terms of Section 4915, *Revised Statutes*, and that the respondent, Jackson Brewing Company, a necessary party, was not subject to the jurisdiction of the District Court under the terms of Section 72 a, Title 35, *U. S. Code* (R. 12 and 13). It was the contention of Jackson Brewing Company that the Commissioner of Patents was not an adverse party and that jurisdiction of the District Court, under the terms of Section 72 a, Title 35, *U. S. Code*, was, therefore, lacking over it, a nonresident defendant (R. 11 and 12).

Appeal was taken from the judgment of the District Court to the Court of Appeals for the District of Columbia and by that Court affirmed, on December 9, 1940 (R. 22), the Court stating in a brief, *per curiam* decision: "This case is governed by *Coe v. Hobart Manufacturing Company*, 70 App. D. C. 2, 102 F. 2d, 270, and *J. C. Eno (U. S.) Limited v. Coe*, 70 App. D. C. 337, 106 F. 2d 858."

Both petitioner and respondent, Jackson Brewing Company, are owners and operators of breweries and both use the term "JAX" as a trade-mark for beer of

their manufacture and sale, petitioner confining its use to the States of Georgia, Florida, South Carolina and North Carolina (R. 3), and respondent confining its use to States other than those named (R. 3).

Petitioner adopted and first used the trade-mark in 1913 (R. 2). Respondent began its use in 1919 (R. 3), and thereafter effected two registrations of the mark in the Patent Office (R. 4).

In 1935, respondent began to invade the trade area of petitioner and as a result of threatened litigation petitioner and respondent entered into a written agreement wherein the rights of each to the trade-mark were recognized and whereby petitioner assigned the mark in all States other than Florida, Georgia, South Carolina and North Carolina to respondent, and respondent assigned the mark to petitioner in the States named (R. 5).

Petitioner has expended more than $500,000 in advertising its wares under the mark "JAX" (R. 3). Its sales have exceeded $2,000,000, and as a consequence thereof it is possessed of a valuable good will and business represented alone by its trade-mark "JAX" (R. 3). The term has come to mean, in the States of Georgia, Florida, South Carolina and North Carolina, the beer and near beer of petitioner (R. 3).

SPECIFICATION OF ERRORS TO BE URGED

The Court of Appeals erred:

1. In holding that the Commissioner of Patents is not a proper and an adverse party to an equitable action under Section 4915, *Revised Statutes*, brought by a de-

feated applicant for cancellation to compel cancellation of a trade-mark registration.

2. In holding that the District Court of the United States for the District of Columbia did not have jurisdiction of the respondent Jackson Brewing Company, under Section 72 a, Title 35, *U. S. Code,* when joined with Commissioner of Patents in equitable action under Section 4915, *Revised Statutes,* by defeated applicant for cancellation of trade-mark registration.

3. In holding that its decision was governed by the cases of Coe v. *Hobart Manufacturing Company,* 70 App. D. C. 2, 102 F. (2d) 270, and *J. C. Eno (U.S.) Limited v. Coe,* 70 App. D. C. 337, 106 F. (2d) 858, and that those cases should not be overruled.

4. In affirming the judgment of the District Court, dismissing the equitable complaint of petitioner for lack of jurisdiction over the respondent, Jackson Brewing Company.

REASONS FOR GRANTING THE WRIT

I.

CONFLICT WITH THIS COURT

The holding that the Commissioner of Patents is neither a proper nor an adverse party as contemplated by the terms and provisions of Section 4915, *Revised Statutes,* is contrary to the decision of this court in the case of *United States ex rel Baldwin v. Robertson, Commissioner,* 265 U. S. 168. It was in that case held that a defeated party in the Patent Office in a trade-mark matter could maintain, under the provisions of Section 4915,

Revised Statutes, a bill in equity against the Commissioner of Patents. Such a holding necessarily recognizes that the Commissioner of Patents, who is charged with the duty of maintaining in the City of Washington a register for the registration of trade-marks, and with protecting the purity and integrity of that register, in accordance with the terms and provisions of the statute establishing it, is a proper and an adverse party in an action affecting it.

II.

CONFLICT BETWEEN CIRCUITS

The decision of the Court of Appeals is in conflict with the decision of the United States Circuit Court of Appeals for the Sixth Circuit, in the case of *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517, wherein that Court held the Commissioner to be a proper party in an equitable action under Section 4915, *Revised Statutes*, and in conflict with the decision of the United States Circuit Court of Appeals for the Third Circuit, in the case of *Drackett Co. v. Chamberlain Co.* 81 Fed (2d) 866, wherein that court expressly held that the Commissioner of Patents was a necessary party in an action under Section 4915, *Revised Statutes*, respecting the Trade-Mark Register. Furthermore, the decision of the Court of Appeals is in direct conflict with the following prior decisions of its own. *Alexandrine v. Coe, Commissioner*, 63 App. D. C. 227, 71 Fed. (2d) 348, and *Hygienic Products Co. v. Coe, Commissioner*, 66 App. D. C. 98, 85 Fed. (2d) 274, which it refused to follow.

III.

QUESTION OF GENERAL IMPORTANCE

The questions decided by the Court of Appeals, and which it is sought to review here, are of grave importance to the public generally, and particularly the industrial public. The principal statute involved, Section 4915, *Revised Statutes*, provides a remedy and relief to persons whose patent and trade-mark rights have been ignored or improperly dealt with by the Commissioner of Patents, and it is of paramount importance to the public to have this Honorable Court construe the statute involved to the end that persons may know what course to follow in the protection of their rights and that their valuable rights may not be lost because of indefiniteness and conflict in decisions of the lower courts, or because of the lower courts' failure to observe and follow the decisions of this Court.

Petitioner, in bringing its bill in equity in the District Court for the District of Columbia against the Commissioner of Patents and the Jackson Brewing Company, thought that it was following meticuously the procedure and course accorded it by the statutes in question, as interpreted by this Court in the case of *U. S. ex rel Baldwin v. Robertson, Commissioner, supra*, and by the Court of Appeals for the District of Columbia in the cases of *Alexandrine v. Coe, Commissioner, supra*, and *Hygienic Products Company v. Coe, Commissioner, supra*. If its action in this respect was improvidently taken as the Court of Appeals has held, it now has no further remedy since the time for further and different action on its part has expired.

CONCLUSION

For the reasons stated, it is respectfully submitted that this petition should be granted.

JAX ICE & COLD STORAGE COMPANY,

By Ernest P. Rogers

March, 1941. *Solicitor for Petitioner.*

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI

The decision sought to be reviewed is at page 22 of the Record.

JURISDICTION

The jurisdiction of this Honorable Court is based upon Section 240 (a) of the *Judicial Code* as amended by the Acts of February 13, 1925.

QUESTION INVOLVED

Concisely stated, the question here involved is whether or not the Commissioner of Patents is a proper and an adverse party in an equitable action under Section 4915, *Revised Statutes,* brought by a trade-mark owner for rectification of the Trade-Mark Register in the protection of his own trade-mark rights.

PRINCIPAL STATUTE INVOLVED

Section 4915, *Revised Statutes,* provides that a defeated or dissatisfied applicant for patent in the Patent Office "may have remedy by bill in equity" and a decree, if entitled to it, adjudging him "entitled, according to law, to receive a patent for his invention." Such adjudication it is provided, "shall *authorize* the Commissioner to issue such patent," upon the applicant doing certain other things specified.

The Statute provides for "notice to adverse parties," and that "in all cases where there is no opposing party a copy of the bill *shall* be served on the Commissioner." It further provides that the record in the Patent Office shall, "where there are adverse parties * * be admitted

in whole or in part, on motion of either party" in the equitable action.

Section 4915, *Revised Statutes* was made applicable to trade-mark matters originating in the Patent Office and effecting the Trade-Mark Register. *Trade-Mark Act of* 1905, sec. 9, (Title 15, *U. S. Code*, sec. 89), and this Court has held that a broad and liberal construction should be given this section of the *Trade-Mark Act* to afford to each of the four classes of applicants in trade-mark matters, the same rights accorded an applicant for patent under section 4915. *American Steel Foundries* v. *Robertson, Commissioner*, 262 U. S. 209, *U. S. ex. rel. Baldwin* v. *Robertson, Commissioner*, 265 U. S. 168.

CONFLICT WITH THIS COURT

This Court, in the case of *U. S. ex rel Baldwin Co.* v. *Robertson, Commissioner, et al.*, 265 U. S. 168, explicitly determined that one of the four trade-mark applicants dissatisfied with the Commissioner's action regarding the Trade-Mark Register might maintain a bill in equity, under Section 4915, *Revised Statutes*, against the Commissioner where there was also another party to the trade-mark matter in the Patent Office.

This decision has been faithfully followed and applied by the Court of Appeals for the District of Columbia. In the cases of *Alexandrine v. Coe, Commissioner*, 63 App. D. C. 227, 71 F. (2d) 348, and *Hygienic Products Co.* v. *Coe, Commissioner*, 66 App. D. C. 98, 85 F. (2d) 274, that Court expressly considered the decision of this Court and followed it.

In this case, the Court of Appeals affirmed the Trial

Court in a *per curiam* decision on the ground that the question presented was "governed by *Coe* v. *Hobart Manufacturing Company*, 70 App. D. C. 2, 102 F. (2d) 270, and *J. C. Eno (U. S.) Limited* v. *Coe*, 70 App. D. C. 337, 106 F. (2d) 858." The last of these cases did not involve the question presented by this Petition. The bill was dismissed in that case "because of the absence of an indispensable party." The first of those cases did involve the question here presented and did decide it adversely to the position herein urged, but nowhere therein did the Court consider, refer to, or even cite the controling case of *U. S. ex rel Baldwin Company* v. *Robertson, Commissioner, supra.*

In those cases of the Court of Appeals wherein *U. S. ex rel Baldwin Co.* v. *Robertson, Commissioner, supra,* has been considered, the contention herein presented has been sustained, and only in the one case referred to, where that decision of this Court was not considered, has there been a contrary holding.

CONFLICT BETWEEN CIRCUITS

The decision sought to be reviewed is in direct conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit, in the case of *Cleveland Trust Company* v. *Berry*, 99 F. (2d) 517, wherein it was held that the Commissioner of Patents is a *proper party* in an equitable action under Section 4915, *Revised Statutes*, even though there be another interested or opposing party; and in conflict with the decision of the Circuit Court of Appeals for the Thrid Circuit, in the case of *Drackett Co.* v. *Chamberlain Co.*, 81 F. (2d) 866, wherein it was held that the Commissioner is a *necessary party* in an ac-

tion under Section 4915, *Revised Statutes,* even though there be other interested or opposing parties.

IMPORTANCE OF THE QUESTION

Section 4915, *Revised Statutes,* and the Act adapting it to trade-mark causes were undoubtedly intended to give the owners of valuable trade-marks an opportunity to resort to an equitable action for a judicial determination of their rights regarding the Register of Trade-Marks.

The Register of Trade-Marks is maintained and its purity and integrity are preserved by the Commissioner of Patents. He is charged with such duties. Since there exists indefiniteness and conflict in the decisions, and no one knows, therefore, exactly what course to pursue in the protection of his valuable trade-mark and patent rights, it is extremely important that the question herein raised be definitely settled by this Court.

Aggrieved trade-mark applicants in the Patent Office have definite time limitations upon their rights to proceed further, and if a wrong course is followed, jurisdictionally, their time for further action has expired. One should be able to readily determine his forum from the statute that provides his procedure and remedy.

THE COMMISSIONER OF PATENTS IS A PROPER AND ADVERSE PARTY

Section 4915, *Revised Statutes,* provides for "remedy by bill in equity." It does not require the Commissioner of Patents, if not made a party to the equitable action, to abide by its outcome, and it does not authorize the courts

to direct the Commissioner of Patents in any respect whatsoever if he is not made a party to the equitable action. It does, however, expressly provide that the Commissioner shall be a necessary party and that a copy of the equitable bill shall be served upon him where there is no opposing party. The statute does not require the Commissioner to be made a party except in the instance recited.

The equitable action under Section 4915, *Revised Statutes*, necessarily contemplates a *case or controversy*. *Cleveland Trust Co.* v. *Berry* (C. A. 6), 99 F. (2d) 517. It requires the Commissioner to be made a party in the instance recited, and it therefore recognizes his status as a party to the equitable action. He must, therefore, be in or taking a position adverse to the plaintiff or he could not be a necessary and the only party in the equitable action.

It has been long assumed by the Commissioner and the Courts of the District of Columbia that the Commissioner is an adverse party in the one instance where he is required by the Statute to be joined. It is provided by the Statute that the record in the Patent Office shall, "where there are adverse parties * * be admitted in whole or in part, on motion of either party," and it is the general practice, when the Commissioner alone is named, for one party or the other to move for admission of the record in the Patent Office in the squitable action, and for the Court to admit it. This would not be authorized by the Statute unless the Commissioner were an adverse party.

If the Commissioner be a necessary and an adverse party in one instance under the Statute, he certainly *may* be a proper and an adverse party in another. Particularly where equitable relief against the adverse position he has taken is prayed.

Equity always does complete justice. One action in equity contemplates complete relief, and complete relief could not be given petitioner in its equitable action under Section 4915 unless the Commissioner were joined as a party. The Statute does not compel him to abide the Court's decision, and the only way to make the one action suffice is to join the Commissioner as a party.

The Court of Appeals passed the matter off, in the case of *Coe* v. *Hobart Manufacturing Co.*, 102 F. (2d) 270, by merely stating that the Commissioner did not care who did or did not register or cancel the registration of a trade-mark, and that he had no interest in a fight between persons over such matters. The frailty of this position seems readily apparent. To hold that one whose principal duty in office is the maintenance and preservation of the Trade-mark Register, has no interest in the purity and integrity of that Register, and in the observance of the rights of those who are entitled to have a mark upon it removed is to flagrantly ignore an obvious fact.

It was contended by respondents that Section 72a, Title 35, *U. S. Code*, was intended by Congress to permit the bringing of an action under Section 4915 in the Dis-

trict of Columbia against a non-resident party only where there were two or more non-resident parties, and that it was not intended to permit an aggrieved applicant to force a single non-resident party to litigate in the District of Columbia rather than the District of his residence.

In considering this contention it should be borne in mind that the Statute was adapted to trade-mark causes insofar only as they arose with respect to the *Register of Trade-Marks*. Litigation under the Statute is concerned with registration and the *Register*. The opposing party came to the District of Columbia where the *Register* is kept and where the Commissioner officially resides when he sought registration, and it seems that he would contend with ill grace in subsequently insisting that it would be a hardship to force him to litigate in the District of Columbia with respect to his position on the *Register*. We believe that Congress intended by Section 72a to give the Courts of the District of Columbia, where the *Register* is kept and where the Commissioner officially resides, jurisdiction whenever it was necessary in an equitable action under Section 4915, for complete and final adjudication of the rights of a litigant, to bring before the Court in the District all persons taking a position adverse to the rights of such litigant. In the instant case the Commissioner has taken and maintained a position adverse to petitioner, and, as petitioner contends, contrary to the Statute under which its rights are defined. Merely to state that he is not an adverse party and is without interest will not suffice.

CONCLUSION

We respectfully submit that the gravity of the question involved and the unsettled state of the decisions and their conflict justify a review by this Honorable Court of the decision complained of.

Respectfully submitted,

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Solicitors for Petioner

APPENDIX

SECTION 4915, REVISED STATUTES:

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, with-

out prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit." (Title 35, *U. S. Code*, Sec. 63.)

SECTION 9, TRADE-MARK ACT OF 1905:

"If an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the United States Court of Customs and Patent Appeals, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, *and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.*" (Italics added.) (Title 15, *U. S. Code*, Sec. 89.)

SECTION 72A, TITLE 35, U. S. CODE:

"Upon the filing of a bill in the district court of United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and

writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct."

Office - Supreme Court, U. S.
FILED
MAR 25 1941
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1940.

No. 823.

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as Jax Brewing Company, *Petitioner,*

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, and JACKSON BREWING COMPANY, a corporation, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia.

BRIEF FOR THE RESPONDENT, JACKSON BREWING COMPANY.

HERBERT H. PORTER.
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Washington, D. C.

ROBERT F. WHITEHEAD.
Munsey Building,
Washington, D. C.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1940.

No. 823.

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as Jax Brewing Company, *Petitioner,*

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, and JACKSON BREWING COMPANY, a corporation, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia.

BRIEF FOR THE RESPONDENT, JACKSON BREWING COMPANY.

Opinions Below.

The orders dismissing the complaint as to the Commissioner of Patents and also dismissing the complaint for lack of jurisdiction appear at pages 16 and 17 of the record.

The decision of the United States Court of Appeals for the District of Columbia appears at page 22 of the record.

Jurisdiction.

Jurisdiction of this court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 15, 1925 (U. S. Code, Title 28, Section 347).

Questions Presented.

The sole question presented in this case is whether the courts of the District of Columbia have jurisdiction in a suit brought under Section 4915 R. S. to effect the cancellation of a trade-mark registration where the named defendants are the Commissioner of Patents and the owner of the trade-mark registration, and the latter is not an inhabitant of the District of Columbia and has not consented to be sued therein.

Statutes Involved.

The applicable portions of the statutes involved, namely Section 4915 R. S. (U. S. Code Title 35, Section 63),* Section 72a, Title 35 U. S. Code, and Section 9 of the Trade Mark Act of February 20, 1905, (U. S. Code Title 15, Section 89) are set forth in the Appendix *infra*, pp. 10, 11.

Statement.

Petitioner filed in the United States Patent Office applications for the cancellation of two trade-mark registrations issued to respondent, Jackson Brewing Company (R. 5). These applications for cancellation were dismissed by the Examiner of Interferences and his decision was affirmed by the Commissioner of Patents (R. 6). The present complaint naming as defendants the Commissioner of Patents and the Jackson Brewing Company was filed August 3, 1939

*Section 4915 R. S. was amended by the Act of August 5, 1939 to be effective two months after the approval of the Act. This approval was subsequent to the filing of the complaint herein and these proceedings are under the statute as it existed prior to that amendment (see Section 5 of the Act).

(R. 1). Petitioner prayed that process issue under the provision of Section 72a, Title 35 of U. S. Code, directed to defendant, Jackson Brewing Company. As appears from the complaint, Jackson Brewing Company is a corporation organized and existing under the laws of Louisiana. It is not an inhabitant of the District of Columbia and has not consented (Special Motion, R. 11) to be sued in the courts of the District of Columbia.

Motions were filed in the District Court by each of the respondents, the Jackson Brewing Company moving to dismiss the complaint on the ground of lack of jurisdiction, and the Commissioner of Patents moving to dismiss the complaint as to him (R. pp. 11 and 12). Both motions were granted by the District Court (R. pp. 17 and 16). Thereafter petitioner took an appeal to the United States Court of Appeals for the District of Columbia. On December 9, 1940 that Court affirmed the judgment of the District Court, stating, in a *per curiam* opinion (R. 22):

> "This case is governed by Coe v. Hobart Manufacturing Company, 70 App. D. C. 2, 102 F. (2d) 270, and J. C. Eno (U. S.) Limited v. Coe, 70 App. D. C. 337, 106 F. (2d) 858. We have carefully considered the earnest and thoughtful argument of appellant's counsel that we should overrule those cases, but we are still of opinion that they were rightly decided. The judgment appealed from is therefore affirmed."

In *Coe* v. *Hobart Manufacturing Company*, 70 App. D. C. 2, 102 F. (2d) 270, the complaint was filed by the unsuccessful party to a patent interference, against the Commissioner of Patents and the successful party, alleging jurisdiction under Section 72a, Title 35 U. S. Code. The Court of Appeals for the District of Columbia directed the dismissal of that suit on the ground that Section 72a, Title 35 U. S. Code is limited to a case where there are adverse parties residing in different Districts not embraced within a single state, and that the Commissioner of Patents was not a party adverse to the plaintiff and therefore the Dis-

trict Court of the United States for the District of Columbia did not have jurisdiction of the suit.

In *Eno* v. *Coe*, 70 App. D. C. 337, 106 F. (2d) 858, the suit was brought by the unsuccessful party in a trade-mark opposition proceeding in the Patent Office against the successful party and the Commissioner of Patents. The registration was granted and the Bill was amended to seek cancellation of that registration. The successful party in the Patent Office was not an inhabitant of the District of Columbia and on motion the bill was dismissed as to him. When the case reached the Court of Appeals for the District of Columbia, that Court held that the bill should have been dismissed for the lack of a necessary party, stating that the validity of a trade-mark registration could not be litigated in a suit to which the owner of the registration was not a party, and that this was elementary and an obvious matter of due proceses.

Contentions of Petitioner.

Petitioner urges in its brief three reasons for the granting of the writ of certiorari:

I. That there is a conflict between the decision of the Court of Appeals and the decision of this Court in *U. S. ex rel. the Baldwin Company* v. *Robertson et al.*, 265 U. S. 168.

II. That the decision of the Court of Appeals in this case is in conflict with the decision of the Circuit Court of Appeals of the Sixth Circuit in the case of *Cleveland Trust Company* v. *Berry*, 99 F. (2d) 517, and with the decision of the Circuit Court of Appeals of the Third Circuit in the case of *Drackett Company* v. *Chamberlain Company*, 81 F. (2d) 866.

III. That the questions decided by the Court of Appeals are of grave importance to the public generally and particularly the industrial public.

Argument.

I. There is no conflict between the decision herein of the Court of Appeals for the District of Columbia and the decision of this Court in *U. S. ex rel. The Baldwin Company* v. *Robertson et al. supra.*

As appears from the decision of this Court, a suit against the Commissioner of Patents had been brought in the Supreme Court of the District of Columbia (now the District Court of the United States for the District of Columbia) to enjoin him from cancelling two registrations in accordance with the decision of the Court of Appeals of the District of Columbia on direct appeal from the Patent Office and the successful party in the cancellation proceeding had intervened. The Court of Appeals reversed the decision of the lower Court and dismissed the bill on the ground that Section 4915 R. S. relates to patents alone and is not applicable to trade-mark cases.

This ground constituted the question which was before this Court on the appeal. There was no question involved as to the Commissioner of Patents being a proper party or as to the right of the plaintiff to bring the suit against the Commissioner of Patents alone since, due to the intervention, both of the interested parties were before this Court.

In its decision this Court with reference to the construction to be given Section 9 of the Trade Mark Act said:

> "We have, in the cases cited, given the closing words of Section 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade-marks which is afforded in proceedings as to patents."

The Court further said:

> "It is not an undue extension of that construction to hold that the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by Section 9 appeal lies first to the Court of Appeals."

It i therefore clear that the Court ruled that the rights accorded to trade-mark applicants are the same as those accorded to patent applicants by the provisions of Section 4915 R. S. and that ruling was the basis of the decision.

The cases in which Section 4915 R. S. can be invoked were two-fold. First, the cases in which a patent had been refused on *ex parte* application, and second, cases where a decision had been rendered in an interference against an applicant involved therein. It had never been held by any court that the losing party to an interference could bring a suit under Section 4915 R. S. to review the decision of the Patent Office except as against the winning party and by bringing that suit in the district of which the latter is an inhabitant. (*Arbetter Felling Machine Co.* v. *Lewis Blind Stitch Machine Co.*, 230 Fed. 992; *Armstrong* v. *DeForest*, 37 F. (2d) 438, and *Hazeltine Corporation* v. *White*, 68 F. (2d) 715.)

If the decision of this Court can be construed to give trade-mark owners the right to bring a suit under Section 4915 R. S. naming the Commissioner of Patents alone as a defendant and bring that suit in the District of Columbia, in a case where there had been a contest in the Patent Office, then the trade-mark owners have not merely the same rights under Section 4915 R. S. that patent applicants have, as this Court expressly ruled, but greater rights.

This Court in the case of *Pacific Steamboat Co.* v. *Peterson*, 278 U. S. 130, pointed out that general statements made in a prior decision as to the construction of a statute where the particular point referred to was not involved in an earlier suit, are not controlling in determining the proper construction of the statute where the point is directly involved.

This Court in that decision, after noting the argument that the construction of the statute was controlled by the statements in the earlier decision, said:

> "This was at most a general expression respecting a particular as to which no question was raised * * * which ought not control the judgment in a subsequent

> suit when the very point is presented for decision * * * or to prevent the determination as an original question of the proper construction of the statute in that particular."

Neither the question of the right to sue the Commissioner of Patents alone nor the question of the Court in which the suit could be brought was involved in *U. S. ex rel. The Baldwin Company* v. *Robertson et al., supra,* and interpreting the decision in that case as required by the decision of this Court in *Pacific Steamboat Co.* v. *Peterson, supra,* there is no conflict between the decision of the Court of Appeals herein and the decision of the Court in the former case.

II. There is no conflict between the decision of the Court of Appeals for the District of Columbia in this case and the decision of the Circuit Court of Appeals of the Sixth Circuit in *Cleveland Trust Company* v. *Berry,* 99 F. (2d) 517. In that case, which was brought under the provisions of Section 4915 R. S. by the losing party to a patent interference in the Patent Office against the winning party, the Court stated that the Commissioner was a proper party and might have intervened, but the Court did not rule that the Commissioner was a necessary party, and, after overruling all of the objections to the validity of the suit, proceeded to determine the case on its merits.

It may be noted that the Court specifically stated that the decree which is entered in a suit under Section 4915 R. S.:

> "* * * has judicial force and immediately and definitely determines the rights of the parties. It becomes the decision of the Patent Office and is to govern the action of the Commissioner."

Nor is there any conflict between the decision in this case and the decisions of the Third Circuit. In *Drackett* v. *Chamberlain,* 81 F. (2d) 866, the Court of Appeals of the Third Circuit stated that the case was properly dismissed because the Commissioner was a necessary party and was

not present, basing that ruling on the ground that there had been no decision between the two parties in the Patent Office since registration of the mark had been refused merely on the ground that it was descriptive and its registration therefore barred by the specific provisions of the Trade Mark Act. No such situation exists in the present case. Furthermore in the later decision of the same Court in *Century Distilling Company* v. *Continental Distilling Corporation,* 106 F. (2d) 486 where, as in the present case, a decision was rendered between the two parties in the Patent Office, the same Court held that the Commissioner of Patents was not a necessary party to the suit under Section 4915 R. S. and stated that the District Court had erred in dismissing the bill on that score.

III. The question decided herein by the Court of Appeals for the District of Columbia is not one of general importance. It does not in any way relate to the right of the losing party in a contested trade-mark proceeding in the Patent Office to bring a suit against the winning party in the Patent Office under the provision of Section 4915 R. S. It relates merely to the Court in which the suit may be brought. Unquestionably the suit could have been brought in the District of which Jackson Brewing Company is an inhabitant.

Section 72a, Title 35 U. S. Code.

The decision in *Hobart Manufacturing Company* v. *Coe, supra,* on which the decision in the present proceeding is in part based merely follows the language of the above statute since the Commissioner of Patents cannot have an interest adverse to any party in a contested proceeding in the Patent Office and therefore cannot be an adverse party within the meaning of that term as used in Section 72a Title 35 U. S. Code.

Conclusion.

There is no conflict of decisions and no question of general importance has been determined. It is submitted therefore that the petition for writ of certiorari should be denied.

Respectfully submitted,

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APPENDIX.

Relevant provision of Section 4915 R. S. (U. S. Code, Title 35, Sec. 63):

> "Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not."

Section 9, Trade Mark Act of 1905 (U. S. Code, Title 15, Sec. 89):

> "If an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the United States Court of Customs and Patent Appeals, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable."

Section 72a, title 35, U. S. Code:

"Upon the filing of a bill in the District Court of United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

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In the Supreme Court of the United States

OCTOBER TERM, 1940

No. 823

JAX ICE & COLD STORAGE COMPANY, A CORPORATION, TRADING AS JAX BREWING COMPANY, PETITIONER

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, AND JACKSON BREWING COMPANY, A CORPORATION

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR RESPONDENT COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The orders of the District Court of the United States for the District of Columbia (R. 16–17) were entered without opinion. The *per curiam* opinion of the United States Court of Appeals for the District of Columbia (R. 21–22) is not yet reported.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered on December 9, 1940 (R. 22). The petition for a writ of certiorari was filed on March 7, 1941. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

The Act of March 3, 1927, confers jurisdiction of suits for the cancellation of a trade mark registration upon the District Court of the United States for the District of Columbia in cases where there are "adverse parties residing in a plurality of districts not embraced within the same State." The question is whether the Commissioner of Patents is an "adverse party."

STATUTES INVOLVED

The pertinent statutes are set forth in the Appendix, *infra*, pp. 11–13.

STATEMENT

On May 21, 1937, and on June 8, 1937, petitioner filed applications in the United States Patent Office praying for the cancellations of two trade mark registrations issued in the name of respondent Jackson Brewing Company (R. 5), a Louisiana corporation (R. 2). Petitioner claimed that the brewing company had abandoned the trade marks by virtue of an agreement with petitioner

consenting to the latter's use of the trade marks in four named states (R. 5). On motion of the Jackson Brewing Company, the applications for cancellation were dismissed by the Examiner of Interferences, and on February 11, 1939, the dismissal was affirmed by the Commissioner of Patents (R. 6).

Thereupon, on August 3, 1939, petitioner brought this action for cancellation in the District Court of the United States for the District of Columbia, joining both the Jackson Brewing Company and the Commissioner of Patents as parties defendant (R. 1–7). The action was purportedly brought under Section 9 of the Trade-mark Act of 1905, c. 592, 33 Stat. 724 (15 U. S. C. Sec. 89) and Section 4915 of the Revised Statutes (35 U. S. C., Supp. V, Sec. 63), and the jurisdiction of the District Court was sought to be maintained under the Act of March 3, 1927, c. 364, 44 Stat. 1394, 35 U. S. C. Section 72 (a).

The Jackson Brewing Company moved to dismiss, on the ground that the District Court had no jurisdiction because the company was a Louisiana corporation and the Commissioner of Patents was not an "adverse party" within the meaning of Section 72 (a), with the result that "the named Defendants do not constitute 'adverse parties residing in a plurality of districts not embraced in the same State' " (R. 11). Thereafter, the Commissioner of Patents moved to dismiss (R. 12–13) on the grounds that he was not a proper party to

the action and that the action could not proceed against him in the absence of the Jackson Brewing Company, a necessary party.

Both motions to dismiss were granted (R. 16, 17). On appeal the court below affirmed, *per curiam* (R. 22).

ARGUMENT

The court below affirmed the judgment sustaining the motions to dismiss on the authority of its prior decisions in *J. C. Eno (U. S.) Limited* v. *Coe,* 106 F. (2d) 858 (App. D. C.) and *Coe* v. *Hobart Mfg. Co.,* 102 F. (2d) 270 (App. D. C.). In the *Eno* case, it held that the person to whom registration had been granted was a necessary party to an action for cancellation of a trade mark and that such an action could not, therefore, be maintained against the Commissioner of Patents alone. In the *Hobart* case (p. 271), it held that the "adverse parties" contemplated by the Act of March 3, 1927, c. 364, 44 Stat. 1394 (35 U. S. C. Sec. 72 (a)), which confers jurisdiction on the District Court of the United States for the District of Columbia "if it shall appear that there" are "adverse parties residing in a plurality of districts not embraced within the same State", are parties adverse to the plaintiff, that the Commissioner was not an "adverse" party in an action to establish priority of invention among private claimants, and that the private defendant must, therefore, be sued at its residence in accordance with the general venue provisions of Section 51 of the

Judicial Code. Petitioner does not deny that the Jackson Brewing Company is a necessary party to this proceeding, but contends that the Commissioner is an "adverse" party for purposes of Section 72 (a), and that the contrary ruling in the *Hobart* case is unsound and in conflict with decisions of other circuit courts of appeals and, indeed, with the prior decisions of the court below. Petitioner's contentions are without merit.

1. The term "adverse parties" as used in Section 72 (a) has reference only to private parties claiming an interest in a patent or trade mark adverse to the plaintiff and does not include the Commissioner of Patents. The occasion for the enactment of Section 72 (a) was that theretofore plural defendants who resided in different districts could not be sued under Section 4915 in any court, because they could not be served in any district. *Coe* v. *Hobart Mfg. Co., supra,* at 272; *Hazeltine Corporation* v. *White,* 68 F. (2d) 715, 717 (C. C. A. 2d).[1] This difficulty arose, and can arise, only where there are a plurality of private defendants and the reach of the statute was plainly intended to be limited accordingly.

Actions to determine priority or ownership have regularly been instituted against a single private defendant at the residence of the defendant with-

[1] The equitable remedy provided by Section 4915, which in terms applies to patent cases only, has been made applicable to trade mark cases by Section 9 of the Trade Mark Act of 1905. *Baldwin Co.* v. *Robertson*, 265 U. S. 168.

out joining the Commissioner. *Cleveland Trust Co.* v. *Berry,* 99 F. (2d) 517 (C. C. A. 6th); *Century Distilling Company* v. *Continental Distilling Company,* 106 F. (2d) 486 (C. C. A. 3d); see *Coe* v. *Hobart Mfg. Co., supra,* at 272. In such proceedings, the court observed *obiter* in the *Berry* case (*supra,* at 520), the Commissioner may be a "proper" party, although this question has never been squarely decided. It is clear, however, that he is not a "necessary" party, even though, under the decision in *Hill* v. *Wooster,* 132 U. S. 693, the question whether the invention is patentable or the trade-mark is entitled to registration may be presented. Cf. *Cleveland Trust Co.* v. *Berry, supra; Century Distilling Company* v. *Continental Distilling Company, supra; Coe* v. *Hobart Mfg. Co., supra.* As petitioner apparently concedes, under Revised Statutes, Section 4915, the Commissioner is not a necessary party and need not be served unless there is "no opposing party." Section 4915, evidently with reference to proceedings in which the Commissioner is not joined, empowers the court to "authorize" the Commissioner to grant (or cancel) a trade-mark or patent, and in practice the Commissioner has almost invariably acted in accordance with the judgment of the court.

2. The decision below is not in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit in *Cleveland Trust Co.* v. *Berry,*

supra, or with that of the Circuit Court of Appeals for the Third Circuit in *Drackett Co.* v. *Chamberlin Co.,* 81 F. (2d) 866. In the *Berry* case the court merely observed *obiter* that the Commissioner was a "proper party" in an action between private claimants under Revised Statutes, Section 4915, to determine priority. The question whether the Commissioner is an "adverse party" within the meaning of 35 U. S. C. Section 72 (a) was not and could not have been presented. And if, as the courts below held, the Commissioner is not an "adverse party" so that the District Court of the United States for the District of Columbia had no jurisdiction of this suit, it is here immaterial whether the Commissioner would be a proper party. Hence no conflict warranting certiorari would in any event arise from the fact that the Commissioner's motion to dismiss gave as one ground that the Commissioner was not a proper party.

The *Drackett* case is clearly distinguishable. In that case an application for registration of a trade-mark was opposed in the Patent Office by a private person claiming ownership of the trade-mark. The registration was denied by the Commissioner on the ground that the trade-mark was not entitled to registration. The court held that since the Commissioner had found that the trade-mark was not entitled to registration the conflicting claimant was not an "opposing party" within the meaning of Revised Statutes, Section 4915,

and that an action to compel registration must be brought against the Commissioner. No question was presented whether the action could have been maintained in the District of Columbia under 35 U. S. C. Section 72 (a). In *Century Distilling Company* v. *Continental Distilling Company,* 106 F. (2d) 486 (C. C. A. 3d), not cited by petitioner, the same court subsequently held that the Commissioner was not a necessary party where registration had been granted and an action was instituted under Section 4915 to determine priority or ownership as between private claimants.[2]

3. The decision of the court below is not in conflict with the decision of this court in *Baldwin Co.* v. *Robertson,* 265 U. S. 168. In that case

[2] The decision below is not inconsistent with the prior decisions of the Court of Appeals of the District of Columbia. In *Alexandrine* v. *Coe,* 71 F. (2d) 348, it was held that an action may be maintained under Revised Statutes, Section 4915, against the Commissioner alone to prevent cancellation of registration. In the *Eno* case the Court of Appeals, without determining whether the *Alexandrine* case had been correctly decided, distinguished the case upon the ground that the person to whom registration has been granted was certainly *a necessary party* regardless of whether the defeated applicant also must be joined. The petitioner does not contend that the Jackson Brewing Company is not a necessary party in this case. *Hygienic Products Co.* v. *Coe,* 85 F. (2d) 264, also cited by petitioner, merely held that a defeated applicant for a trade-mark application need not first appeal to the Court of Customs and Patent Appeals before resorting to a suit in equity under Section 4915. The question whether the Commissioner is an "adverse party" within the meaning of 35 U. S. C. Section 72 (a) was not raised or considered.

the court merely held that the provisions of Revised Statutes, Section 4915, which in terms apply only to patents, were made applicable to trade-marks by Section 9 of the Trade-mark Act of 1905. In the course of its opinion the court stated that a party whose application for cancellation of a trade-mark had been rejected by the Patent Office could resort to a suit in equity against the Commissioner under Section 4915. The question whether the Commissioner could be sued, however, or whether the Commissioner was a necessary party in an action against a private claimant where the application for cancellation had been rejected was not in issue and does not appear to have been given consideration. See *J. C. Eno (U. S.) Limited* v. *Coe, supra,* at 859. Moreover, the *Baldwin* case was decided before the enactment of 35 U. S. C. Section 72 (a), and it is clear that the court did not expressly or inferentially hold that the Commissioner was an "adverse party" within the meaning of that statute.

4. No question of importance is presented. Where there are only two opposing parties claiming an interest in a patent or trade-mark it has heretofore been the settled practice to determine the question of priority in an action instituted at the residence of one of the claimants. There is thus no reasonable doubt as to the procedure to be followed in such cases. And

the fact that the petitioner, having elected to follow a novel course of action, has lost any right to judicial review because of the expiration of the statutory period, obviously does not present a question of general interest.

CONCLUSION

For the foregoing reasons it is respectfully submitted that the petition should be denied.

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MARCH 1941.

APPENDIX

Section 4915 of the Revised Statutes (35 U. S. C., Supp. V, Sec. 63) provides as follows:

> Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be ad-

> mitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Section 9 of the Trade-mark Act of 1905, c. 592, 33 Stat. 724 (15 U. S. C. Sec. 89) provides as follows:

> If an applicant for registration of a trade mark, or a party to an interference as to a trade mark, or a party who has filed opposition to the registration of a trademark, or party to an application for the cancellation of the registration of a trade mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the United States Court of Customs and Patent Appeals, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

The Act of March 3, 1927, c. 364, 44 Stat. 1394 (35 U. S. C., Sec. 72 (a)), provides as follows:

> Upon the filing of a bill in the district court of United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a

foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

U. S. GOVERNMENT PRINTING OFFICE: 1944

MAR 26 1941

IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 821.

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as Jax Brewing Company, *Petitioner*,

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, and JACKSON BREWING COMPANY, a corporation, *Respondents*.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia.

REPLY BRIEF OF PETITIONER

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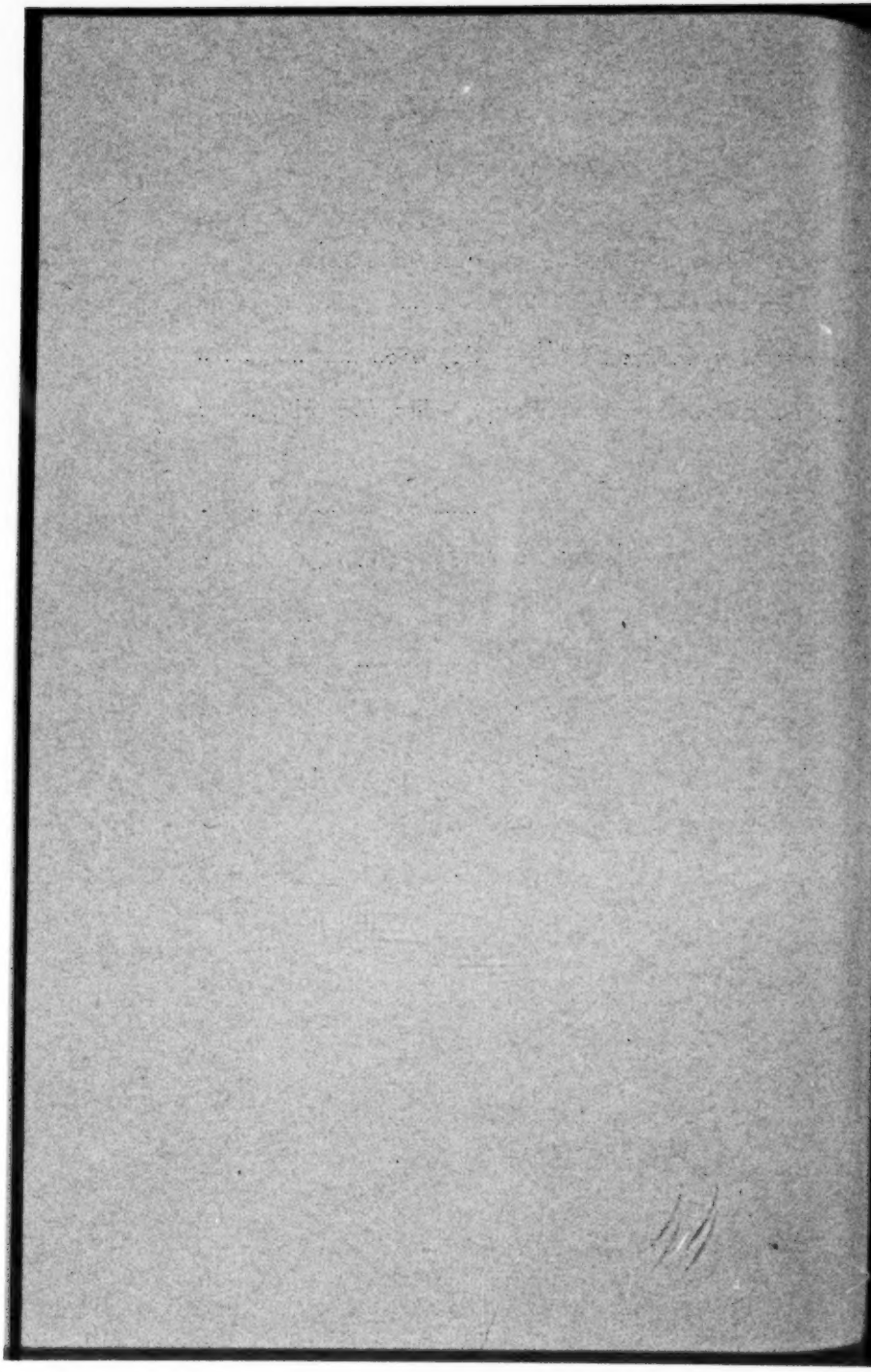

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Section 9, *Trade-Mark Act of* 1905 (Title 15, *U. S. Code*, Sec. 89) 2

IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 823.

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as Jax Brewing Company, *Petitioner,*

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, and JACKSON BREWING COMPANY, a corporation,

Respondents

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia.

REPLY BRIEF OF PETITIONER

In answering the brief of Respondent, Jackson Brewing Company, we call this Honorable Court's attention, first, to the fact that Section 4915, *Revised Statutes*, provides for a *bill in equity* in the District Courts of the United States, and necessarily and obviously contemplates a *case or controversy*. There must, therefore. be adverse parties.

The statute specifically provides that where there is no *opposing party* the Commissioner of Patents shall be a necessary party. We submit, therefore, that the statute itself ex-

pressly recognizes that the Commissioner of Patents is an adverse party else he could not be made a necessary party in the instance recited.

This court in the case of *U. S. ex rel. The Baldwin Company v. Robertson et al.*, 265 U. S. 168, held that an aggrieved party in a trade-mark matter in the Patent Office had a right, under Section 4915, *Revised Statutes*, to bring a bill in equity for the enforcement of his contended rights, and this holding was made in a proceeding brought in the District Court for the District of Columbia, in which the successful party in the Patent Office proceeding (a non-resident of the District of Columbia) and the Commissioner of Patents were parties. An injunction against the Commissioner was held in this case to be proper, and we respectfully submit that a basis for the decision of this court in that case was the adversity of the Commissioner of Patents and his status as a *proper* if not under the circumstances a *necessary* party.

Section 4915, *Revised Statutes*, gives the right to a bill in equity only to an aggrieved *applicant for patent*, and other parties in patent proceedings have no recourse to the statute. This court held in the *Baldwin* case that the same remedy provided an aggrieved applicant for patent was, by Section 9 of the *Trade-Mark Act* of 1905, provided each of the three or four different applicants in trade-mark matters, including an applicant for cancellation of a trade-mark registration. With this in mind, the cases of *Arbetter Felling Machine Co. v. Lewis Blind Stitch Machine Co.*, 230 Fed. 992; *Armstrong v. DeForest*, 37 Fed. (2d) 438, and *Hazeltine Corporation v. White*, 68 Fed. (2d) 715, and other decisions in actions under Section 4915 involving patent matters, are better understood.

The Respondent expressly recognizes that Section 4915,

Revised Statutes, contemplates a case or controversy, and it refers expressly to the decision of the Circuit Court of Appeals for the Sixth Circuit in the case of *Cleveland Trust Company v. Berry*, 99 Fed. (2) 517, in which that court expressly held that a case or controversy was contemplated by the statute, and that the Commissioner of Patents if not a necessary party was at least a proper party. We respectfully submit that this express ruling of the Sixth Circuit Court of Appeals necessarily recognizes the adversity of the Commissioner of Patents and is in direct conflict with the decision of the Court of Appeals for the District of Columbia in this case and in the case of *Coe v. Hobart Manufacturing Company*, 102 Fed. (2) 270, and in direct conflict with the decision of the Circuit Court of Appeals for the Third Circuit in the case of *Drackett v. Chamberlain*, 81 Fed. (2d) 866, wherein that court held that the Commissioner of Patents was not only a proper party, but a *necessary* party in an action under Section 4915, *Revised Statutes*.

It is well recognized by that portion of the bar specializing in the law of patents and trade-marks, that widespread confusion, jurisdictionally and otherwise, exists with respect to causes of action and the rights of Patent Office applicants and parties under Section 4915, *Revised Statutes*, and we state, without equivocation, that the bar itself would, if given an opportunity, plead earnestly with petitioner for an enlightening decision of this Honorable Court.

Respectfully submitted,

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